



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,894	02/20/2004	Joseph J. Kubler	14364US18	7624
23446 7590 06/09/2011 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661				
EXAMINER				
CAMPBELL, MATTHEW T				
ART UNIT		PAPER NUMBER		
2465				
NOTIFICATION DATE		DELIVERY MODE		
06/09/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mhmpto@mcandrews-ip.com

Office Action Summary

Application No.

10/783,894

Applicant(s)

KUBLER ET AL.

Examiner

MATTHEW CAMPBELL

Art Unit

2465

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-57-59-63-65-84 and 86-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-57-59-63-65-84 and 86-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-7-2011 has been entered.
2. Claims 44-57, 59-63, 65-84 and 86-131 are presented, of which the independents are 44, 63 and 71.

Response to Arguments

For the §112 rejection of claims 50-52 and 77-79

The rejection is withdrawn since the amended claims omit performing conversion between two packet networks.

For the §112 rejection of claims 92, 95 and 98

The specification describes using the propagation delay to determine the buffering period of time during the communication of voice; however, the specification does not describe comparing the propagation delay variation to a certain level. See below.

For the §103 rejections

Applicant's arguments have been carefully considered, but they are moot in view of the new grounds of rejection in view of Suffern.

Claim Rejections - 35 USC § 112 2nd

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 44-57, 59-63, 65-84 and 86-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 44, 63 and 71 substitute the amended "directions" with the previously recited "configuration information" and "call parameters". It is unclear how this affects the scope of the claims. The specification refers to the host device receiving dialed numbers and comparing them to a cross-reference database (see pgpub at ¶598+). It is vague as to whether applicant is now referring to something else. Dependent claims 45-57, 59-62, 65-70, 72-84 and 86-131 inherit this deficiency.

Claim 96 refers to "the period of time"; however, parent claim 126 has no antecedent basis therefor. For the purpose of examination it will be interpreted to depend from claim 127.

Claim Rejections - 35 USC § 112 1st

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 44-57, 59-63, 65-84 and 86-131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 44, 63 and 71 recite coupling one of at least two communication networks to either a packet network or another of the at least two communication networks; however, the specification does not teach two communication networks in combination with a packet network. At most the specification teaches coupling one communication network with a packet network (**couple incoming call from telephone switching network 5605 with premises network 5503 over internal routing path, figs 55a, 56a and pgpub ¶¶622-625**). The specification teaches two networks, not three. Thus, the spec does not support the claim in a manner consistent with 112 1st. Dependent claims 45-57, 59-62, 65-70, 72-84 and 86-131 inherit this deficiency.

Claims 116, 122 and 128 recite wherein the [buffering] period of time is based upon a level of variation in propagation delay; however, the specification states that the this time is based upon a combination of the maximum and nominal routing times (**see pgpub ¶¶620**). The variation in routing times [propagation delay] is used to determine

when the routing times are calculated, with slow variation causing calculation during call setup and much variation causing calculation during the call session (**see pgpub ¶621**). Thus, the spec does not support the claim in a manner consistent with 112 1st.

Claims 92, 95 and 98 recite determining the buffering period of time during the communication of voice if the variation of the propagation delay of the packet network is above a certain level; however, the specification only recites slow variation causing calculation during call setup and much variation causing calculation during the call session (**see pgpub ¶621**). The difference between slow and much variation fails to support the narrowly claimed certain level. Thus, the spec does not support the claim in a manner consistent with 112 1st.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 44, 63 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Isreal et al. (US 4723238 A).

For claim 44, Isreal teaches a method of operating a device for communicatively coupling one of at least two communication networks, each having an associated

information format **(CSS 12 and port circuit 122-K to other CSS 'two communication networks', fig. 1 and col. 2 lines 40-46. Multiple PSS 13 systems, col. 13 lines 1-13)**, to either a packet network **(PSS 13 'packet network', fig. 1 and col. 2 lines 52-63)** or another of the at least two communication networks, the method comprising:

receiving, from the packet network or the one of at least two communication networks, information requesting setup of a call between the one of at least two communication networks and either the packet network or another of the at least two communication networks **(network interface card 14 receives call originating from packet terminal 131-X or circuit terminal 121-X or other circuit network 122-K, fig. 1 and col. 3; CSS-PSS call, col. 3 lines 22-44 and col. 9 line 15; CSS-CSS call, col. 3 lines 45-54; and PSS-CSS call, col. 3 line 55 - col. 4 line 11 and col. 11 line 20)**;

providing, to a host device, at least a portion of the information requesting setup of a call **(Terminal 121-1 dials a data call request to call processor (CP) 123. The CP 123 checks a terminal location table (201 of FIG. 2) to determine if the destination terminal 131-M is located in CSS 12 or PSS 13. Since destination terminal 131-M is located on PSS, CP 123 forwards the call request to NIC 14 'host device', col. 3 lines 24-30)**;

receiving, from the host device, directions based upon the at least a portion of the information requesting setup of a call **(The NIC 14 acts like a terminal on PSS 13 and attempts to complete the data call to destination terminal 131-M. If the data call set-up on PSS 13 is successful, NIC 14 notifies CP 123 accordingly 'directions', col. 3 lines 30-33)**; and

communicatively coupling the one of at least two communication networks to either the packet network or another of the at least two communication networks, according to the directions from the host device **(The CP 123 then selects a data converter (e.g., 145D) for the call and sends an appropriate message back to the originating terminal 121-1. The data transmission path for the established data call includes originating terminal 121-1, port circuit 122-1, TDM bus 124, T/R 147, data bus 154, NPE 152, data converter 145D, NAU bus 146, CSMA interface controller 141, NAU 132-1 and destination terminal 131-M, col. 3 lines 33-41).**

Claim 63 is rejected for the same reason as claim 44, except that it is directed to a machine readable medium.

Claim 71 is rejected for the same reason as claim 44, except that it is directed to an apparatus.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW CAMPBELL whose telephone number is (571)270-3988. The examiner can normally be reached on Monday through Friday from 9:00am until 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARSHA D. BANKS HAROLD/
Supervisory Patent Examiner, Art Unit 2465

/M. C./
Examiner, Art Unit 2465
6-4-2011